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10/768,311

01/30/2004

Alfred Adler

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MOTOROLA INC
600 NORTH US HIGHWAY 45
W4 - 39Q
LIBERTYVILLE, IL 60048-5343

EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

2453

NOTIFICATION DATE

DELIVERY MODE

02/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DOCKETING.LIBERTYVILLE@MOTOROLA.COM
ADB035@Motorola.com

| | | | |
|------------------------------|-----------------|--------------|--|
| <i>Office Action Summary</i> | Application No. | Applicant(s) | |
| | 10/768,311 | ADLER ET AL. | |
| | Examiner | Art Unit | |
| | AARON STRANGE | 2453 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The preliminary amendment filed 1/30/2004 cancelling claims 1-10, amending the specification and adding figure 7 has been entered. Claims 11-26 are now pending and have been examined herein.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 11 and 19-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claim 11 is directed to a "computer" comprising only an "interface". Based on the specification, the claimed interface appears to be the "virtual client software" (Spec., p. 6, ll. 3-4). A claim directed to software *per se* is non-statutory. Since the claim is not limited to statutory subject matter, it is non-statutory.

5. Claim 19 is directed to a "host computer" comprising only an "account table" and "a command message receiver". The specification describes these elements as portions of the "virtual client software" (Spec., p. 6, ll. 3-9). Since the claim is not limited to statutory subject matter, it is non-statutory.

6. All claims not individually rejected are rejected by virtue of their dependency from the above claims and their failure to correct the above noted deficiencies.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 11-13, 15, 16, 19, 20 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. ("Trials of Wireless, Secure Electronic Mail").

9. With regard to claim 11, Smith discloses a computer (CC:Mail or Microsoft mail server)(p. 29, col. 2, ll. 5-16) configured to send and receive electronic mail comprising:

an interface configured to enable a user of a mobile radio device associated with the computer to access multiple existing email accounts using the mobile radio device (multiple users/accounts may share a single mobile device by entering user information at each system connection)(p. 32, col. 2, ll. 4-17).

10. With regard to claim 12, Smith discloses a communication system comprising:
a host computer (CC:Mail or Microsoft mail server)(p. 29, col. 2, ll. 5-16);

an electronic mail database accessible by the host computer and configured to manage a plurality of email accounts (CC:Mail or Microsoft Mail Post Office)(p. 29, col. 2, ll. 5-16; p. 31, col. 1, ll. 2-6); and

a mobile radio device (notebook or palmtop) (p. 32, col. 1, ll. 12-28) having a radio device address (devices communicate via packet radio or cellular digital packet data, and)(p. 28, col. 1, ll. 32-26) and configured to send and receive email messages via the host computer and to access the plurality of email accounts (multiple users/accounts may share a single device to send and receive messages)(p. 29, col. 2, ll. 5-16; p. 32, col. 2, ll. 4-17),

wherein the host computer is configured to correlate the radio device address of the mobile radio with one of the plurality of email accounts (inherent aspect of the system, since messages from the accounts are delivered to the device associated with the user whose account is accessed)(p. 29, col. 2, ll. 5-16), and

wherein the mobile radio device is configured to permit a user of the mobile radio device to send a message to the host system to access a different one of the plurality of email accounts (device may optionally send new user information with each system connection to allow multiple users/accounts to share a single mobile device)(p. 32, col. 2, ll. 4-17).

11. With regard to claim 13, Smith further discloses a gateway (CC:Mail or Microsoft Mail router) (p. 31, col. 1, ll. 2-3) configured to give the host computer access to a public

12. With regard to claim 15, Smith further discloses a local area network connected to the host server and including a plurality of computer terminals (fig. 1).

13. With regard to claim 16, Smith further discloses that the user of the radio device has an email account associated with the communication system; and the user can access the email account using wither the computer terminals or the radio device (users may access their account with a LAN based client or access the same features using the mobile client)(p. 29, col. 2, ll. 9-13; p. 30, col. 2, ll. 67-68).

14. Claims 19, 20 and 22-24 are rejected under the same rationale as claims 11-13, 15 and 16, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

While the Examiner believes that reference to the above provided citations is sufficient to understand the applicability of the cited references to claims 19, 20, and 22-24, if Applicant has any questions regarding the interpretation of the cited references, he/she is invited to contact the Examiner for clarification.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 14 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. ("Trials of Wireless, Secure Electronic Mail") in view of Fabrik Communications ("A White Paper on Electronic Mail and Business-to-Business Communications").

17. With regard to claim 14, while the system disclosed by Smith shows substantial features of the claimed invention (discussed above), it fails to disclose that the host computer is connected to the Internet in order that the radio device can send messages to recipients not directly associated with the host computer.

Fabrik Communications discloses a system for connecting a LAN-based email system, such as the CC:Mail and Microsoft Mail systems used by Smith, to remote recipients via the internet (pp. 5-6). This would have been an advantageous addition to the system disclosed by Smith since it would have allowed users of existing LAN-based email systems to communication with users outside their network, without requiring them to use a different email system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the host computer to the Internet to enable the radio device to send messages to remote recipients not directly associated with the host computer.

18. Claim 21 is rejected under the same rationale as claim 14, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

19. Claims 17, 18, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. ("Trials of Wireless, Secure Electronic Mail") in view of Vajket al. (US 5,265,033).

20. With regard to claim 17, while the system disclosed by Smith shows substantial features of the claimed invention (discussed above), it fails to disclose that the radio device is configured to send pre-defined messages stored in a memory of the radio device to at least one message recipient selected by the user of the radio device.

Vajk teaches sending pre-defined electronic mail messages (col. 14, ll. 22-26). This would have been an advantageous addition to the system disclosed by Smith since it would have allowed commonly used messages to be stored and send without being entered multiple times, which would have been particularly advantageous on devices

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with small keyboards, such as the palmtop devices used by Smith (Smith, p. 32, col. 1, ll. 23-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the radio device to store and send pre-configured messages so that frequently used messages could have been sent without requiring re-entry of the message each time, making it faster and easier to send messages.

21. With regard to claim 18, while the system disclosed by Smith and Vajk shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the predefined messages stored in the memory of the radio device include "OK" and "I'm unable to reply, right now".

Nonetheless, one of ordinary skill in the art would have recognized that the predefined messages could contain any information desired by the user, and that the specific claimed examples are merely predictable variations of the virtually unlimited quantity of messages that could be stored for later use.

One of ordinary skill in the art would have recognized that "OK" and "I'm unable to reply, right now" are commonly used messages and would have recognized the advantages of storing these particular messages to reduce the amount of time and user interaction needed to compose them.

Furthermore, it is noted that claim 18 is directed to the specific data contained in the messages. The specific data in the messages does not functionally change the

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claimed system. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 21 7 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

In this case, the difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material, which is presumed to be well within the level of ordinary skill in the art at the time the invention was made. See *Ex Parte Curry*, Appeal No. 2005-0509 (Appl. No. 09/449,237) (*aff'd*, Appeal No. 06-1003 (Fed. Cir. Jun. 12, 2006)(Rule 36)(unpublished)).

22. Claims 25 and 26 are rejected under the same rationale as claims 17 and 18, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Examiner, Art Unit 2453